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FORM PTO-1083

Attorney Docket No.: 108.0003-00001  
Customer No. 22882

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Steven Michael Schein

Serial No: 09/605,695

Filed: June 28, 2000

For: INTELLIGENT MEDIA TARGETING  
SYSTEM AND METHOD

Confirmation No.: 6334

Art Unit: 3622

Examiner: Arthur Duran

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a Notice of Appeal in reply to the Final Office Action dated January 9, 2006 in the above-identified application.

- ☐ No additional fee is required.
- ☒ Applicant hereby requests a three-month extension of time to respond to the above office action.
- ☒ A Form PTO/SB/33 and Pre-Appeal Brief Request for Review are enclosed.
- ☒ A total fee in the amount of \$1,520 to cover the \$1,020 three-month extension of time fee and \$500 Notice of Appeal fee is to be charged to Deposit Account No. 50-1068.
- ☒ The Commissioner is hereby authorized to charge any deficiencies of fees associated with this communication or credit any overpayment to Deposit Account No. 50-1068. **A copy of this sheet is enclosed.**
- ☒ Any filing fees under 37 C.F.R. § 1.16 for the presentation of extra claims
- ☒ Any patent application processing fees under 37 C.F.R. § 1.17

Respectfully submitted,  
MARTIN & FERRARO, LLPBy: Amedeo F. Ferraro  
Registration No. 37,129

Date: July 10, 2006

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RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3764

PATENT  
Attorney Docket No. 108.0003-00000  
Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Confirmation No.: 6334
Steven Michael Schein	)	
Serial No.: 09/605,695	)	Group Art Unit: 3622
Filed: June 28, 2000	)	Examiner: Arthur Duran
For: INTELLIGENT MEDIA TARGETING)	)	
SYSTEM AND METHOD	)	

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In reply to the Final Rejection dated January 9, 2006, Applicant submits the following remarks for consideration by the Members of the pre-appeal brief conference.

**I. Brief Background**

The application includes eight independent claims generally drawn to an intelligent media targeting system and method, of which two have been withdrawn. Independent claims 1, 9, 17, 22, 27, and 29 stand rejected. In response to a third non-final Office Action mailed June 9, 2005, Applicant submitted a Reply dated December 7, 2005 (the "Reply") traversing the Examiner's rejection under 35 U.S.C. § 103(a). The Examiner mailed a Final Office Action on January 9, 2006 withdrawing claims 25, 26, and 32-37 while maintaining the rejections over the remaining claims.

**II. Clear Errors or Omissions**

(1) The Examiner's rejection of claims 1-7, 9-15, 17-20, 22, 23, and 25-37 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,892,900 to Ginter et al. in view of U.S. Patent No. 5,848,396 to Gerace is erroneous because:

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Pre-Appeal Brief Request For Review dated July 10, 2006  
Reply to Final Office Action of January 9, 2006

(a) attempting to modify the Ginter system of rights management to additionally function to target audiences based on behavioral profiles according to the Gerace system would require undue experimentation (see Reply, page 4, paragraphs 1 and 2);

(b) Ginter and Gerace do not disclose a system for targeting media to a user based on user interaction with a media object where a mediator provides to "at least one user at least a second media object based upon said user activity information correlated with at least said first media object" as recited in independent claim 1 (see Reply, paragraph bridging pages 2 and 3);

(c) Ginter and Gerace do not disclose a system for targeting media to a user based on user interaction with a media object where the system includes "a coding system for assigning user activity information" to "at least one of said stored media objects to create a profile for said at least one of said stored media objects" and "a mediator for selecting at least one of said stored media objects having a media object profile matching at least one characteristic of said profile of said user requested media object" as recited in independent claim 9 (see Reply, page 3, paragraph 1);

(d) Ginter and Gerace do not disclose a method for targeting media to a user based on user interaction with a media object that includes the steps of "matching at least one characteristic of said media object profile of said user requested media object with said media object profile of at least a second media object" and "delivering said user requested media object with at least said second media object having an object profile matching at least one characteristic of said media object profile of said user requested media object" as recited in independent claim 17 (see Reply, page 3, paragraph 2);

(e) Ginter and Gerace do not disclose a method for targeting media to a user based on user interaction with a media object that includes the steps of combining a "media object profile with said at least one user requested media object to create a smart media object" and "selecting at least one smart media object having a media object profile matching at least one characteristic of said media object profile of said user requested media object and delivering said user requested media object with said

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Pre-Appeal Brief Request For Review dated July 10, 2006  
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at least one selected smart media object" as recited in independent claim 27 (see Reply, page 3, paragraph 4); and

(f) Ginter and Gerace do not disclose all of the elements of independent claims 22 and 29 (see Reply, paragraph bridging pages 3 and 4).

(2) The Examiner's rejection of claims 1-7, 9-15, 17-20, 22, 23, and 25-37 under 35 U.S.C. § 103(a) as being obvious over Ginter in view of Gerace contains an omission because it does not state how each and every element of each claim is either disclosed or rendered obvious by the combination. (See Reply, page 2, paragraph 2).

(3) The Examiner's inclusion, in the rejection of the claims, of language relating to the "hidden search engine" of claim 32 is erroneous because this claim was withdrawn by the Examiner in the Final Office Action. (See Final Office Action, page 3, paragraph 2, and page 20, paragraph 3).

(4) The Examiner's remarks under the "Response to Arguments" section contains at least the following errors:

(a) Applicant did not make any argument concerning "improper hindsight reasoning" in the Reply (see Final Office Action, page 21, paragraph 3); and

(b) Applicant did not make any argument concerning "non-analogous art" in the Reply (see Final Office Action, page 21, paragraph 4).

(5) The Examiner's remarks under the "Response to Arguments" section that "[h]owever, Gerace discloses these features" contains an omission because it is not stated what "features" are being referred to by the Examiner. (See Final Office Action, page 24, paragraph 2).

### III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Members of the Pre-Appeal Brief Conference reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any

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Reply to Final Office Action of January 9, 2006

fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,  
MARTIN & FERRARO, LLP

Dated: July 10, 2006

By: \_\_\_\_\_

  
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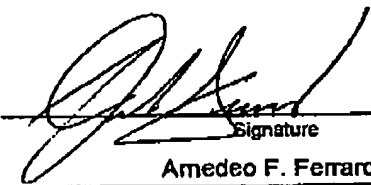
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PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>108.0003-00000</b>							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Application Number <b>09/605,695</b></td> <td style="padding: 5px;">Filed <b>June 28, 2000</b></td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor <b>Steven Michael Schein</b></td> </tr> <tr> <td style="padding: 5px;">Art Unit <b>3622</b></td> <td style="padding: 5px;">Examiner <b>Arthur Duran</b></td> </tr> </table>		Application Number <b>09/605,695</b>	Filed <b>June 28, 2000</b>	First Named Inventor <b>Steven Michael Schein</b>		Art Unit <b>3622</b>	Examiner <b>Arthur Duran</b>
Application Number <b>09/605,695</b>	Filed <b>June 28, 2000</b>								
First Named Inventor <b>Steven Michael Schein</b>									
Art Unit <b>3622</b>	Examiner <b>Arthur Duran</b>								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>									
I am the  <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>37,129</b>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">             Signature  <b>Amedeo F. Ferraro</b>            Typed or printed name         </div> <div style="text-align: center;"> <b>(310) 286-9800</b>            Telephone number         </div> <div style="text-align: center;"> <b>July 10, 2006</b>            Date         </div>							
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.									
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**TO:**

**Name:** Mail Stop AF  
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**Subject:** U.S. Patent Application No. 09/605,695  
Steven Michael Schein  
Filed: June 28, 2000  
INTELLIGENT MEDIA TARGETING SYSTEM  
AND METHOD

Attorney Docket No. 108.0003-00000

Customer No. 22882

Confirmation No.: 6334

**FROM:**

**Name:** Amedeo F. Ferraro

**Phone No.:** 310-286-9800

**No. of Pages (including this):** 9

**Date:** July 10, 2006

**Confirmation Copy to Follow:** NO

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**Message:**

**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that the attached Transmittal Form (in duplicate; \$1,520.00 total fee to cover the \$1,020 three-month extension fee and \$500 appeal fee is to be charged to Deposit Account No. 50-1068), Notice of Appeal, and Form PTO/SB/33 with Pre-Appeal Brief Request for Review are being facsimile transmitted to the U.S. Patent and Trademark Office on July 10, 2006.

  
Sandra L. Blackmon

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